UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/663,701	09/15/2000	Kia Silverbrook	NPA047US	2195

24011 7590 01/16/2004

SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041
AUSTRALIA

EXAMINER	
LAMB, TWYLER MARIE	

ART UNIT	PAPER NUMBER
2622	

DATE MAILED: 01/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/663,701	KIA SILVERBROOK, ET AL.	
	Examiner	Art Unit	
	Twyler M. Lamb	2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 September 2000*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-34* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-34* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-7, 9-12, 16-18, 20-27 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Dougherty et al. (Dougherty) (US 6,076,734).

With regard to claims 1 and 20, Dougherty discloses a method for enabling instruction of a computer to perform tasks, the method including the steps of: providing a user with at least one form printable on a surface to provide one or more first viewable information zones relating to one or more available commands and one or more second

viewable information zones relating to one or more objects (col 6, line 58 – col 7, line 8); receiving, in a computer system, indicating data from a sensing device operated by the user regarding movement of the sensing device relative to the surface, said movement including a stroke of part of the sensing device on or relative to said surface (col 7, lines 14-25); determining, in the computer system and from the indicating data, if the stroke substantially links one or more of said first viewable information zones with one or more of said second viewable information zones (col 7, line 26-32), and thereby interpreting the stroke as designating (i) a respective one or more of said available commands (col 7, lines 33-51) and (ii) a respective one or more of said objects (col 7, lines 52-56); and applying in the computer system the designated one or more of said available commands to the designated one or more of said objects (col 7, lines 63-65).

With regard to claims 2 and 21, Dougherty also discloses wherein said at least one form includes coded data indicative of at least one reference point of the form, and said indicating data regarding movement of the sensing device relative to the surface is generated by way of the sensing by the sensing device of its movement relative to the surface using at least some of the coded data (col 7, lines 14-25).

With regard to claims 3 and 22, Dougherty also discloses wherein said at least one form includes coded data indicative of an identity of the form, and said indicating data from the sensing device includes data regarding the identity of the form (col 8, lines 33-46).

With regard to claims 4 and 23, Dougherty also discloses wherein said indicating data is provided by way of the sensing device generating data regarding its own movement relative to the surface (col 7, lines 14-25).

With regard to claims 5 and 24, Dougherty also discloses including the step of identifying, in 1he computer system and from said indicating data, if the stroke has encircled one or more of said second viewable zones relating to one or more objects, thereby designating said one or more objects (col 7, lines 1-32).

With regard to claims 6 and 25, Dougherty also discloses including the step of identifying, in the computer system and from said indicating data, if the stroke has intersected one or more of said second viewable zones relating to one or more objects, thereby designating said one or more objects (col 7, lines 14-25).

With regard to claims 7 and 26, Dougherty also discloses at least one of said second viewable zones having a viewable boundary, and including the step of identifying, in the computer system and from said indicating data, if the stroke has crossed said boundary more than once, and to apply a different one or more of said available commands if such an occurrence is identified (col 7, lines 14-25).

With regard to claims 9 and 29, Dougherty also discloses including the step of identifying, in the computer system and from the indicating data, if a user has effected the stroke to designate one or more of said second viewable zones and extend to intersect with one or more of said first viewable zones (col 7, lines 14-25).

With regard to claim 10, Dougherty also discloses for designation of a feature of said one or more objects such that said designated one or more of the available commands is carried out with respect to that feature (col 7, lines 52-65).

With regard to claim 11, Dougherty also discloses wherein said designated feature is a color attribute of said designated one or more objects, and the method includes the step of setting the value of said color attribute according to the designated one or more commands (col 10, line 45 – col 11, line17).

With regard to claim 12, Dougherty also discloses including the step of providing the user with a further form printable on a surface including one or more viewable information zones relating to said designated one or more of said objects, said one or more zones including representations of the designated one or more objects rendered according to the value of the color attribute (col 10, line 45 – col 11, line17).

With regard to claim 16, Dougherty also discloses including retaining a retrievable record of each form generated, the form being retrievable using its identity as contained in its coded data (col 7, lines 14-25).

With regard to claim 17, Dougherty also discloses in which the sensing device contains an identification means which imparts a unique identity to the sensing device and identifies it as being associated with a particular user and in which the method includes monitoring, in the computer system, said identity (col 7, lines 14-25).

With regard to claim 18, Dougherty also discloses providing all required information relating to said one or more available commands on the at least one form, to eliminate the need for a separate display device (col 7, lines 52-65).

With regard to claim 27, Dougherty also discloses including the sensing device (sensing element 13).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 8 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dougherty et al. (Dougherty) (US 6,076,734) in view of Sekendur (US 5,852,434).

With regard to claims 8 and 28, Dougherty does not teach wherein said part of the sensing device includes a marking nib and said stroke is able by way of said marking nib to provide a visible marking on said surface.

Sekendur discloses an optical position determining apparatus that includes wherein said part of the sensing device includes a marking nib and said stroke is able by way of said marking nib to provide a visible marking on said surface (col 5, line 63 – col 6, line 10).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Dougherty to include wherein said part of the sensing device includes a marking nib and said stroke is able by way of said marking nib to provide a visible marking on said surface as taught by Sekendur. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified

Dougherty by the teaching of Sekendur to write and scan simultaneously as taught by Sekendur in col 5, line 63 – col 6, line 10.

6. Claims 13-15,19 and 30-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dougherty et al. (Dougherty) (US 6,076,734) in view of Mondshein (US 4,418,278).

With regard to claims 13 and 30, Dougherty does not teach the surface being provided by a laminar substrate, the method including printing said at least one form on the substrate on demand.

Mondshein discloses a fabricated optic fiber page that includes the surface being provided by a laminar substrate, the method including printing said at least one form on the substrate on demand (col 6, lines 28-63).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Dougherty to include the surface being provided by a laminar substrate, the method including printing said at least one form on the substrate on demand as taught by Mondshein. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Dougherty by the teaching of Mondshein to provide an unobtrusive natural interface for communicating with a computer as taught by Mondshein in col 2, lines 23-41.

With regard to claims 14 and 31, Dougherty does not teach the surface being provided by a laminar substrate, the method including printing said at least one form on

the substrate on demand, and, at the same time, printing the coded data on the substrate.

Mondshein discloses a fabricated optic fiber page that includes the surface being provided by a laminar substrate, the method including printing said at least one form on the substrate on demand, and, at the same time, printing the coded data on the substrate (col 6, lines 28-63).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Dougherty to include the surface being provided by a laminar substrate, the method including printing said at least one form on the substrate on demand, and, at the same time, printing the coded data on the substrate as taught by Mondshein. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Dougherty by the teaching of Mondshein to provide an unobtrusive natural interface for communicating with a computer as taught by Mondshein in col 2, lines 23-41.

With regard to claims 15 and 32, Dougherty as modified also discloses including printing the coded data to be substantially invisible in the visible spectrum (col 7, line 26-32).

With regard to claim 19, Dougherty does not teach the laminar substrate being providable as a paper page, and in which the at least one form is printable on multiple pages and the method includes binding the pages.

Mondshein discloses a fabricated optic fiber page that includes the laminar substrate being providable as a paper page, and in which the at least one form is

printable on multiple pages and the method includes binding the pages (col 6, lines 28-63).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Dougherty to include the laminar substrate being providable as a paper page, and in which the at least one form is printable on multiple pages and the method includes binding the pages as taught by Mondshein. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Dougherty by the teaching of Mondshein to provide an unobtrusive natural interface for communicating with a computer as taught by Mondshein in col 2, lines 23-41.

With regard to claim 33, Dougherty as modified also discloses including a printer for printing on the laminar substrate (col 9, lines 21-49).

With regard to claim 34, Dougherty as modified does not teach including a binding means to bind multiple items of said laminar substrate, to cater for a form printed on multiple pages.

Mondshein discloses a fabricated optic fiber page that includes including a binding means to bind multiple items of said laminar substrate, to cater for a form printed on multiple pages (col 8, lines 32-48).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Dougherty to include including a binding means to bind multiple items of said laminar substrate, to cater for a form printed on multiple pages as taught by Mondshein. It would have been obvious to one of ordinary skill in the art at

the time of the invention to have modified Dougherty by the teaching of Mondshein to provide an unobtrusive natural interface for communicating with a computer as taught by Mondshein in col 2, lines 23-41.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Twyler Lamb whose telephone number is 703 - 308-8823. The examiner can normally be reached on M-TH (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L Coles can be reached on 703-308-4712. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9314 for After Final communications.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

or faxed to:

(703) 872-9314
(for informal or draft communications, such as proposed amendments to be discussed at an interview; please label such communications "PROPOSED" or "DRAFT")

or hand-carried to:

Crystal Park Two
2121 Crystal Drive
Arlington. VA.
Sixth Floor (Receptionist)

Twyler Lamb

January 12, 2004